Notice of Allowability	Application No. 10/664,179	Applicant(s) PLATZER ET AL.	
	Examiner John S. Chu	Art Unit 1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to *9/17/03*.

2. ☒ The allowed claim(s) is/are *1-27*.

3. ☐ The drawings filed on _____ are accepted by the Examiner.

4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
   a) ☒ All b) ☐ Some* c) ☐ None of the:
      1. ☐ Certified copies of the priority documents have been received.
      2. ☒ Certified copies of the priority documents have been received in Application No. *09/904,205* .
      3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

   * Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.

6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
   (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
      1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
   (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.

   Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).

7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date 11/28/03
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413), Paper No./Mail Date _____ .
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____.

EXAMINER'S AMENDMENT

1. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

The application has been amended as follows:

Claim 20, line 2 replace "a" with - - an- - to correct a grammatical error.

Claim 26, line 1, replace "soluable" with - - soluble - - to correct typographical error.

REASONS FOR ALLOWANCE

2. The following is an examiner's statement of reasons for allowance: The claimed invention is drawn to the following:

> 1. A method of making an imageable element comprising the steps of:
>
> providing a substrate;
>
> applying onto the surface of the substrate a photosensitive composition comprising:
>
> a mixture of an aromatic diazonium salt containing compound having an alkoxy substituent and an aromatic diazonium salt containing compound free of an alkoxy substituent; and
>
> treating the photosensitive composition to form a layer that adheres to the surface of the substrate.

The application is a continuation of U.S. SN 09/904,205, now U.S. Patent 6,638,679. The claimed invention is drawn to a method of making an imageable element having the steps of

providing a substrate, applying and treating the photosensitive composition as recited above. The method is basically a coating method wherein the photosensitive layer is applied and treated to leave a photosensitive layer on a substrate. The inventive step is found in the photosensitive composition, which recites the mixture of an aromatic diazonium salt containing an alkoxy substituent and an aromatic diazonium salt containing a compound free of an alkoxy substituent. The parent case to 09/904,205 recites the following wherein claim 40 recites a method of producing an imaged element:

> 1. An imageable element selected from the group consisting of: a first and a second imageable element;
> said first imageable element comprising an imaging layer which comprises: a mixture of an aromatic diazonium salt containing compound having an alkoxy substituent and an aromatic diazonium salt containing compound free of an alkoxy substituent; a polyvinyl acetal binder; and a sheet substrate; and
>
> said second imageable element comprising an imaging layer which comprises: a mixture of an aromatic diazonium salt containing compound having an alkoxy substituent and an aromatic diazonium salt containing compound free of an alkoxy substituent and a sheet substrate; wherein said imaging layer comprises a total aromatic diazonium salt containing compound content of at least 10 weight percent; and wherein the molar ratio of said aromatic diazonium salt containing compound having an alkoxy substituent to said aromatic diazonium salt containing compound that is free of an alkoxy substituent is from about 1.0:1 to 70:1.

The differences between the claims are to making a imageable element to producing an imaged element. One is a process for making an element to be used and the other is a process of using a previously formed element. Because of this distinction, the claims are not seen as rejectable over the judicially created doctrine of obviousness-type double patenting.

Prior art previous cited include the following:

WALLS et al discloses a photosensitive element comprising a diazonium resin and a polyvinyl acetal resin wherein in column 3, lines 55-et seq. WALLS et al discloses that two or more of the diazotized structures are reacted with a paraformaldehyde to give two types of diazonium salts in the composition. WALLS et al lacks the use of two different diazonium resins in an explicit example in a mixture of an aromatic diazonium salt containing compound having an alkoxy substituent and an aromatic diazonium salt containing compound free of an alkoxy substituent.

AOSHIMA et al discloses a negative working recording material comprising an acrylic resin, a diazo compound and carbon black. The diazo compound having two or more diazonio groups on the polymer. This fails to meet or anticipate the claimed mixture of the aromatic diazonium salt containing compound having an alkoxy substituent and the aromatic diazonium salt containing compound free of an alkoxy substituent.

VERMEERSCH et al discloses a diazo-based element having improved storage stability comprises at least one diazo resin or diazonium salt containing as a substituent an alkyl or alkoxy group. This reference also fails to disclose the claimed imageable element having the mixture of the aforementioned diazonium resins.

Because none of the prior art references of record disclose the recited method, claims 1-27 are seen as allowable and passed to issue.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Chu whose telephone number is (571) 272-1329. The examiner can normally be reached on Monday - Friday from 9:30 am to 6:00 pm.

The fax phone number for the USPTO is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1700.

Information regarding the status of an application may be obtained from the Patent Application lnformation Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PMR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

John S. Chu
Primary Examiner, Group 1700

J.Chu
November 15, 2004